

Attorney Docket No. CNTW-023/01US

PATENT



Express Mail Label Number: EV459982313US Date of Deposit: December 13, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 13, 2005.

By: Sherry Duncan Bitler
Sherry Duncan Bitler

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of J. S. WOLF

Confirmation No.: 9526

Serial No.: 09/877,209

Group Art Unit: 2136

Filed: 06/08/2001

Examiner: P. PARTHASARATHY

FOR: NETWORK CONFIGURATION MANAGER

Mail Box AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action of June 13, 2005, Applicants respectfully request a review of the above-identified matter prior to filing of an Appeal Brief. A Notice of Appeal is filed herewith under 37 C.F.R. 41.31. Applicants submit that a review is appropriate because the Office Action includes rejections based on clear errors of law and fact.

ARGUMENT

Claims 1, 2, 4, 30, 31, 33, 34, 66-69 and 76-79 remain pending.

Error in the Application of Best Mode Law

The Examiner has rejected independent claims 1 and 78 on the basis that these claims do not comply with the best mode requirement. Applicants strongly disagree and

submit that the Examiner has misapplied the first paragraph of 35 U.S.C. §112 and request the rejection be removed. In particular, 35 U.S.C. §112 recites in pertinent part:

The *specification* shall... set forth the best mode contemplated by the inventor of carrying out his invention. (Emphasis Added).

The Examiner, however, inappropriately rejects claims 1 and 78 under the best mode requirement on the basis that the *claims* do not recite subject matter *that is disclosed in the specification*. Specifically, the Examiner first states that:

the specification discloses “a network configuration management system includes [sic] a policy engine which generates configlets based on...and a selected device to be configured. The configlets can be vendor-neutral, vendor specific, or both.” , [sic] and “The policy engineconstructs for the containment policies.” []

The Examiner then states:

Independent *claims* 1 and 78 do not explicitly state how the configuration files are generated and do not disclose “a policy engine which generates configlets” and “a translator/combiner to translate and combine the configlets to form vendor-dependent configuration files.” (Emphasis Added).

Based upon the Examiner’s statements, it is clear the Examiner has misapplied the law and may not appreciate that the Examiner is alleging that Applicants have concealed subject matter known to the Applicants at the time of filing; thus the rejection is improper and Applicants respectfully request such a finding.

Even if the Examiner properly applied the law, only evidence of concealment (accidental or intentional) is to be considered. See Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987). Applicants submit that the Examiner has tendered no such evidence. Accordingly, the rejection is legally improper.

Rejections for Lack of Written Description Under 35 U.S.C. §112, First Paragraph

The Examiner has also rejected claims 1, 2, 4, 30, 31, 33, 34 and 76-79 on the basis that the specification does not disclose “a configuration file generator.” Applicants disagree, and submit the specification includes more than sufficient detail to lead one of skill in the art to conclude that Applicants possessed the claimed “configuration file generator.” For example, in one embodiment, described with reference to FIG. 4, a “configuration file generator” is realized by a combiner 65 that combines configlets “to generate...vendor-specific configurations 66.” (Applicants’ specification page 11, lines 6-12).

In another embodiment, a “configuration file generator” is realized by a translator/combiner 64/65 depicted in FIG. 12, which generates a configuration file, at least in part, by combining converted configlets 62 “into a configuration 66 with appropriate vendor-specific format for the device.” (Applicants specification page 18, lines 10-12).

In yet another embodiment, a “configuration file generator” is realized by a translator 64/combiner 65 (described with reference to FIG. 22), which generates a configuration file by combining translated configlets into a partial “vendor specific configuration 630.” (See Applicants specification, page 29, lines 15-17).

None of this material appears to have been considered. Accordingly, the rejection is improper.

Claim Rejections Under 35 U.S.C. §102(e)

Claims 1, 2, 4, 30, 31, 33, 34, 66, 68, 69 and 76-79 stand rejected on the basis that the claims are anticipated by US 6,167,445 (Gai). Applicants submit this rejection is improper because Gai does not teach each and every limitation of the claimed invention.

With respect to claims 1 and 78, the Examiner presumably contends that Gai's policy translator 410 corresponds to Applicants "reverse translator." Gai's policy translator 410, however, simply does not receive "a vendor-specific configuration file from a network device." In particular, Gai teaches that their policy translator 410 receives policy information from a repository 326—not a network device such as a switch or a router.

Moreover, Gai's policy translator does not appear to translate anything from a vendor-specific arrangement into a vendor neutral arrangement. As a consequence, the Examiner has not identified any teaching of Applicant's "reverse translator."

Finally, Gai's policy information can not correspond to Applicants' "vendor specific configuration file," because their policy information is "not usable to configure the operation of" a network device.

With respect to independent claim 66, the Final Office Action points to column 12, lines 41-56 and column 13 line 63-column 14, lines 3-33 in support for the anticipation rejection. First, *Gai's* network user table 710 and service allocation are not related to login information or the step of accessing a configuration setup on a network device as is recited in claim 66. (See, e.g., Applicants' February 24, 2005 Amendment and Response to Office Action, pages 8 and 9). Second, *Gai* does not disclose maintaining login information at both the network device and at the configuration server

as claim 66 recites. In fact, the *Gai* material cited by the Office Action does not disclose maintaining login information at any location. (See, e.g., Applicants' February 24, 2005 Amendment and Response to Office Action, page 9)

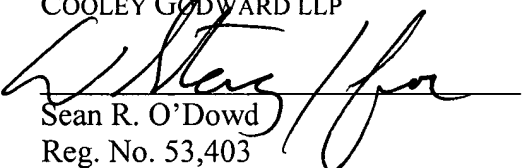
Applicants would like to make clear that the arguments presented herein are merely those that are most appropriate for pre appeal brief review and are certainly not the only arguments related to patentability. Additional and more detailed arguments are expressly reserved for an Appeal Brief, if necessary.

SUMMARY

The best mode, written description and rejections under §102(e) are improper and claims 1, 66 and 78 and dependent claims 2-34, 67-77 and 79 are allowable. Applicants respectfully request such a finding for the reasons set forth herein. The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper.

COOLEY GODWARD LLP
Attention: Patent Group
One Freedom Square - Reston Town Center
11951 Freedom Drive
Reston, Virginia 20190-5601
Tel: (720) 566-4035
Fax: (720) 566-4099

Respectfully submitted,

COOLEY GODWARD LLP
By: 
Sean R. O'Dowd
Reg. No. 53,403